

REMARKS

In response to the examiner's requirement for election of species among species I-VI identified by the examiner, applicant elects species II.

Applicant petitions against the requirement for election of species insofar as it implicates species I-III on the ground that it is not in accordance with PTO practice concerning election of species.

Election of species practice is governed by 37 CFR 1.146, which provides that the examiner may make a requirement for election of species in the first action on an application containing a generic claim and claims to more than one species embraced thereby. The action under reply is the third action in this case and therefore is not permitted under 37 CFR 1.146.

Further, species I-III are identified by reference to paragraphs 4 and 9 of the specification. These paragraphs relate to the background of the invention. Paragraph 4 describes the scope of the term "information apparatus" and paragraph 9 discusses the input requirements of an output device. MPEP 806.04(e) states that claims are never species and that species always refer to the different embodiments of the invention. The examiner's requirement for election of species does not identify any embodiment of the invention as described in the detailed description starting on page 12 of the specification and is therefore improper.

In addition, the examiner's requirement for election identifies the alleged species with reference to features that are omitted ("species that does not requires the limitation of...") rather than features that are present. Referring by way of example to claim 1 and the dependent claims 22-25, it is logically erroneous to say that a computer readable medium encoded with software that does not support the feature of the wireless information apparatus being able to output images to a printing device without need to install an output driver specific to that printing device is patentably distinct from a computer readable medium encoded with software that does not support the feature of the wireless information apparatus being able to output images to a display device without need to install an output driver specific to that display device because a claim drawn to either of these species, as defined by the examiner, would be rejected as being

indefinite on the ground that it does not define the subject matter that applicant regards as the invention.

Moreover, referring again to claim 1 and claims 22-25, because the examiner has defined species by reference to what is omitted rather than what is included, the species propounded by the examiner do not exclude the possibility of the computer readable medium including an additional feature that renders the computer readable medium patentable. A computer readable medium including the hypothetical additional feature but encoded with software that does not support the feature of the wireless information apparatus being able to output images to a printing device without need to install an output driver specific to that printing device (species I) would not apparently be patentably distinct from a computer readable medium including the hypothetical additional feature but encoded with software that does not support the feature of the wireless information apparatus being able to output images to a display device without need to install an output driver specific to that display device (species II). Unless the definitions of the species specify features that are present in the respective species, it is not possible to say whether the species are patentably distinct.

Further, requiring applicant to make an election of species based on negatively defined features forces applicant into an impossible position. If applicant elected species I (which excludes the feature of "without need to install an output driver specific to a [printing device]" but permits the feature of "without need to install an output driver specific to a [display device]"), apparently applicant could not amend the claims by excluding the latter feature (and thereby narrowing the claims) because the claims would then be drawn to species II.

Claims 29-35 are readable on species II.

The claims readable on applicant's elected species include claims 31-35. Applicant elects the examiner's invention VIII.

Respectfully submitted,



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